

### REMARKS

Please reconsider this application in view of the above amendments and the following remarks.

- Claims 1-39 are pending.
- The Examiner has rejected Claims 1-39.

#### Rejections under 35 U.S.C. §112

The Examiner has rejected Claims 1-39 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

The Examiner believes that the degree of smoothness meant by "smooth" is unclear. Applicant traverses this rejection. One ordinary skill in the art would interpret this claim to cover a coating made smoother by adjusting the pressure in the chamber than the coating would have been if the pressure was not adjusted, as described in the specification as a whole, .

Please remove this rejection.

#### Art-based Rejections

The Examiner has rejected all of the outstanding claims either based on 35 U.S.C. §102 or §103 in view of a reference to Panagiotou, U.S. Patent No. 6,143,370, or in view of a combination of references in which the '370 patent is the base reference.

The Examiner takes the position in this rejection that a decrease in chamber pressure during coating will inherently produce a smoother coating in the invention of the '370 patent. See page 3, first full paragraph, of the current office action. There is no factual support for this statement.

M.P.E.P. § 2144.03 states that “the rationale for supporting an obviousness rejection may be based on common knowledge in the art or ‘well-known’ prior art” and the “examiner may take official notice of facts outside of the record which are *capable of instant and unquestionable demonstration* as being ‘well-known’ in the art.” If an applicant traverses such an assertion, the Examiner is required to cite a reference in support of the office’s position. Applicant traverses the assertion that a decrease in chamber pressure during coating will inherently produce a smoother coating in the invention of the ’370 patent and asks for a reference demonstrating this assertion. If the Examiner decides not to provide such a reference, applicant requests that the Examiner remove the claim rejections that the Examiner based on this assertion. Moreover, applicant requests that the Examiner expressly remove this statement of “facts” from the record.

Moreover, the teachings of the ’370 patent directly contradict the Examiner’s statement:

The novelty of the present invention rests in the property that when the formed droplets hit the surface to be coated, they are not quite liquid but are not quite dry either. Thus, when the droplets hit the surface, they readily adhere to the surface. They may deflate or they may wrinkle, but they remain more or less discrete particles rather than diffusing and forming a smooth coating. (emphasis added).

Furthermore, with respect to a rejection based in part on inherency, the law is clear. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.” MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.” MPEP § 2112 (quoting *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The ’370 patent specifically teaches that “applying at a reduced pressure” causes less smoothness. A single instance that contradicts an allegedly inherent characteristic vitiates an inherency argument. Because the ’370 patent teaches that “applying at a reduced pressure” causes

less smoothness, the Examiner's contention that a decrease in chamber pressure during coating will inherently produce a smoother coating in the invention of the '370 patent is incorrect.

Therefore, please remove these rejections.

All independent claims recite that adjusting the pressure of the chamber to a pressure other than ambient pressure results in the medical device having a smoother coating surface. Therefore, all independent claims are patentable over the cited references.

Please remove this rejection of the independent claims.

All dependent claims depend from one of the independent claims, and therefore, contain all of the limitations of the independent claims. This makes the dependent claims patentable for at least the same reason given for the independent claims.

Please remove the rejection of the dependent claims, as well.

Furthermore, because the Examiner has not made out prima facie obviousness or anticipation, Applicant is under no duty to address the remainder of the Examiner's discussion in these sections of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in these sections.

Since all claims are allowable, please issue a Notice of Allowability directed at these claims.


If I can be of any help, please contact me.

Respectfully submitted,

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